REMARKS

In the Office Action, the Examiner made final the restriction requirement. Although Applicants do not agree with the propriety of the restriction requirement, in an effort to speed prosecution of this application to allowance, Applicants agree to the finalization and withdrawal of claims 20-22 without prejudice to their assertion in a timely filed divisional application.

The Examiner then stated that the Affidavit filed on September 22, 2005 under 37 CFR 1.131 is ineffective to overcome the applied references because "Kenneth J. Heater has been designated as a representative of the assignee of the instant application, however no evidence has yet to be provided as to why the inventor(s) are unavailable to sign the affidavit." Applicants are resubmitting the Affidavit with the signatures of all the joint inventors. Therefore, Applicants respectfully request that the Affidavit be entered and considered.

The Examiner then withdrew the previously applied rejections of claims 2, 8 and 11 under 35 U.S.C. 112, second paragraph due to amendment. Applicants thank the Examiner for the withdrawal.

The Examiner then withdrew the rejection of claims 1-8 and 17 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakajima et al. (U.S. Pat. No. 6,261,995). Applicants thank the Examiner for the withdrawal.

The Examiner then rejected claims 4 and 5 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In response, Applicants respectfully request reconsideration and removal of this ground of rejection.

More particularly, Applicants respectfully submit that the Examiner has misread claims 4 and 5 as amended. In the Office Action, the Examiner stated that claims 4 and 5 disclose "limitations upon a pretreatment for the laminate, but [do] not disclose how this treatment or its limitations impact the final laminate structure to be instantly claimed." However, claims 4 and 5 as amended do disclose the impact of the treatment on the final laminate: each laminate "exhibits improved homogeneity and more consistent laminates" when pretreated. Therefore, Applicants respectfully request removal of this ground of rejection.

The Examiner then rejected claims 1-7 and 13-15 under 35 U.S.C. 102(b) as anticipated by Majumdar et al. (U.S. Pat. No. 6,025,119). In response, Applicants have amended claim 1 to claim substantial independence from humidity. Applicants respectfully submit that this

amendment does not add new matter because support for the amendment is found at, *inter alia*, page 5, lines 4-7 of the specification as originally filed. In contrast, Majumdar teaches that relative humidity of from 50%-5% is required. (Col. 6, lines 26-27). Therefore, Applicants respectfully request removal of this ground of rejection.

The Examiner then rejected claims 1-5, 13, 15, 16, and 19 under 35 U.S.C. 102(e) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yeager et al. (PG Pub 2001/0053820). Applicants respectfully request reconsideration and removal of this ground of rejection. More particularly, Applicants respectfully submit that the subject matter of the rejected claims was invented prior to the earliest effective date of the Yeager reference. In support, Applicants are resubmitting an affidavit under 37 C.F.R. 1.131 with exhibits which establishes conception of the invention before the effective date of the Yeager reference. Therefore, Applicants respectfully request removal of this ground of rejection.

The Examiner then rejected claims 1, 2, 3, 5, 12 and 17 under 35 U.S.C. 102(b) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dzenis et al. (U.S. Pat. No. 6,265,333). In response, Applicants respectfully request reconsideration and removal of these grounds of rejection.

More particularly, Dzenis requires two distinct sizes of fibers in order to implement its teachings. (Col. 7, lines 45-47). Therefore, the teachings of Dzenis are inapplicable and not anticipatory to the claimed invention that requires only one fiber size (i.e., nano) to be used. Because claim 1, as amended, claims only "***a*** conductive nanophase material..." (emphasis added), Applicants' invention is not anticipated by the Dzenis reference, which clearly does not teach the use of only one sized fiber. Additionally, Applicants invention is not rendered obvious in view of the teachings of Dzenis because, again, Dzenis teaches that two fiber sizes are required. There is no suggestion, disclosure, or teaching in Dzenis to use only one sized fiber. In fact, as discussed above, Dzenis explicitly requires two sizes of fibers. Thus, one of ordinary skill in the art would not find it obvious to modify the teachings of Dzenis in order to create that which Applicants claim as the invention. Therefore, Applicants respectfully request reconsideration and removal of these grounds of rejection.

The Examiner next rejected claims 1-3, 9-11, and 17 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Follensbee et al.

(U.S. Pat. No. 6,239,049). Applicants respectfully request reconsideration and removal of this ground of rejection.

More particularly, Applicants respectfully submit that the Examiner has misconstrued the disclosure of Follensbee. The Examiner notes that Follensbee teaches the use of antistatic additives such as carbon black and graphite. Additionally, the Examiner argues that the present invention's property of possessing a point-to-point resistance in the range of 10^6 to 10^9 ohms when tested in accordance with ESD S4.1 would have been present in the Follensbee product. Applicants respectfully disagree. Claim 1 as amended claims a structure with the cited range, comprising a conductance-modifying component. Therefore, the amount of the component is an inherent part of the claim, insomuch as the amount of the conductance-modifying component is directly related to obtaining the cited range. However, Follensbee allows the optional component only "as long as the amount of the additive used does not adversely affect the performance characteristics of the end-use product or article." (Col. 8, lines 41-43). The amount of component required to yield a point-to-point resistance in the range of 10^6 to 10^9 ohms when tested in accordance with ESD S4.1 would presumably be a different amount from what would be allowed by Follensbee. Follensbee is concerned with coating compositions for **abrasive** backings. (Col. 1, lines 7-8; *see also* Abstract). Graphite and carbon black are useful as **lubricants**. (Exhibits A at 1 and B at 13). Therefore, very little graphite or carbon black can be used by Follensbee and still achieve its goal of being abrasive. Thus, Applicants respectfully submit that enough carbon black or graphite could not be used by Follensbee to obtain the resistance range of 10^6 to 10^9 ohms while still having the abrasiveness specifically required by Follensbee. Therefore, Applicants respectfully request removal of these grounds of rejection.

The Examiner then rejected claim 18 under 35 U.S.C. 103(a) as being unpatentable over Dzenis et al. In response, Applicants respectfully request reconsideration and removal of this ground of rejection.

More particularly, as noted above, Dzenis requires two distinct sizes of fibers in order to implement its teachings. (Col. 7, lines 45-47). Therefore, the teachings of Dzenis are unworkable if only one fiber is used. There is no suggestion, disclosure, or teaching in Dzenis to use only one sized fiber. Thus, one of ordinary skill in the art would not find it obvious to modify the teachings of Dzenis in order to create that which Applicants claim as the invention.

In this respect, Therefore, Applicants respectfully request reconsideration and removal of this ground of rejection.

Lastly, the Examiner rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over Majumdar et al. (U.S. Patent No. 6,025,119) as applied to claim 7, and further in view of Nakajima et al. (U.S. Patent No. 6,261,995). Applicants respectfully request reconsideration and removal of this ground of rejection.

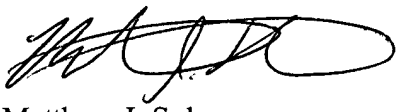
First, Applicants respectfully submit that this rejection is in error for the reasons set forth above regarding Claim 1 from which Claim 8 depends. Still further, Applicants respectfully assert that it would not be obvious to one of ordinary skill in the art to combine the teachings of Majumdar with the disclosure of Nakajima. There is no suggesting, teaching, or disclosure in Majumdar which would render it obvious to use Kraft paper. Furthermore, the Examiner seems to be engaging in impermissible hindsight when stating "[t]he applied invention is silent as to the size of the 'fine particles' but it is reasonable to presume that the tin oxide particles are of a nanoscale or it would have been obvious to one of ordinary skill in the art to have used nanoscale tin oxide particles." Applicants agree that Nakajima teaches that "the antistatic agent contained in the back coat layer includes conductive fine particles such as...tin oxide..." (Col. 7, lines 60-63). However, the term "fine particles" is properly read as referring to particles measured on the microscale rather than the nanoscale. The term "μm" (i.e., "micrometer") appears in Nakajima at least seventy times; the term "nm" (i.e., "nanometer") appears in Nakajima only about ten times and refers exclusively to the wavelength of light. Therefore, Nakajima only teaches the use of the microscale, not the nanoscale. Thus, it would not be obvious to one of ordinary skill in the art to utilize fine particles measured on the nanoscale.

Furthermore, even if it was obvious to combine the two references (which Applicants do not concede), that which Applicants claim as the invention still would not be created. Nakajima teaches a **surface** specific resistance of more than **$2x10^9$ to not more than 10^{12} ohms/m^2** under **relative humidity of not more than 80%** (Col. 2, lines 54-56; Abstract). Claim 1 as amended explicitly claims a "a **point-to-point** resistance which is **independent of relative humidity** in the range **of 10^6 to 10^9 ohms** when tested in accordance with ESD S4.1." (emphasis added) Therefore, by combining Majumdar with Nakajima, one would create a substance with a surface resistance (rather than the point-to-point resistance Applicants claim) from between $2x10^9$ to 10^{12} ohms/m^2 (rather than the 10^6 to 10^9 ohms Applicants claim) at less than 80% humidity (rather

than being independent of humidity, as Applicants claim). Therefore, Applicants respectfully request removal of this ground of rejection.

Based on the above, Applicants respectfully submit that the claims of the present invention are in proper form for allowance. Favorable consideration and early allowance are therefore respectfully requested and earnestly solicited.

Respectfully submitted,



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